

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Group Art Unit:  
EDWARDS, Roger. ) Examiner:  
Serial No.: 09/744,772 )  
Filed: January 25, 2001 )  
For: COPY PROTECTION OF DIGITAL )  
AUDIO COMPACT DISCS )

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JAN 24 2002

Technology Center 2100

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231 on October 26, 2001.

  
Signature

10-26-01  
Date

PETITION TO MAKE SPECIAL UNDER 37 CFR 1.102(d)

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Dear Sir:

The applicant, Macrovision Corporation, respectfully submits this Petition to Make Special for the above-identified patent application for reason of infringement as allowed under 37 CFR 1.102(d). The grounds and conditions for granting this application special status can be found in Section 708.02 II -Infringement- of the MPEP.

The applicant believes that at least some of the claims in the above-identified patent application are being infringed. This Petition to Make Special is filed because a patent is needed to obviate such infringement. In support of this Petition as required by Section 708.02 II -Infringement- of the MPEP, attached please find a Declaration by Frank Nguyen, the attorney of record.

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The Commissioner is hereby authorized to charge the  
Petition Fee of \$130 and any additional fees which may be  
required to Deposit Account: 13-0762.

Respectfully submitted,

Date OCTOBER 26, 2001

Frank Nguyen

Frank Nguyen

Registration No. 39,790

Phone: 408-743-8424

Fax: 408-743-8615

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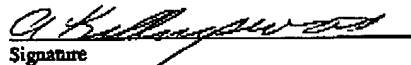
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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EDWARDS, Roger. ) Examiner: **RECEIVED**  
Serial No.: 09/744,772 ) **JAN 24 2002**  
Filed: January 25, 2001 ) **Technology Center 2100**  
For: **COPY PROTECTION OF DIGITAL**  
**AUDIO COMPACT DISCS** )

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**Technology Center 2100**

DECLARATION OF FRANK NGUYEN

Dear Sir:

I, Frank Nguyen, hereby declare:

1. I am the in-house Patent Counsel and attorney of record for the applicant, Macrovision Corporation, in the above-identified application.

2. I am a member of the bar of the State of California (Registration No. 174,072) and a registered Patent Attorney (Registration No. 39,790).

3. I make this declaration in support of the Petition to Make Special in the above-identified application.

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2. Based on my understanding, the above-identified application currently claims a copy protection technology to prevent the illicit copying of digital audio compact discs.

3. It has come to the attention of Macrovision Corporation that Midbar Tech Ltd., a competitor of Macrovision Corporation, is offering for license at least one copy protection product, Cactus Data Shield CDS-200, to prevent illicit copying of audio compact discs and that this product is being field-tested by some recording studios in the United States.

4. As a result of this awareness, acting on behalf of Macrovision Corporation I have authorized Ms. Jacqueline Needle, a Chartered Patent Agent in the UK who is also the original drafter of the above-identified patent application, to perform a formal infringement analysis of the Midbar CDS-200 copy protection product relative to the pending claims of the above-identified patent application.

5. Based on Ms. Needle's analysis, Midbar CDS-200 copy protection product infringes at least Claims 1 and 2, 7 to 13, and 18 to 21 of the pending claims. Attached is a copy of a letter stating her conclusion.

6. I have reviewed the pending claims of the above-identified patent application in light of my understanding of the Midbar CDS-200 copy protection product.

7. I agree with Ms. Needle's assessment that the Midbar CDS-200 copy protection product infringes at least some of the pending claims in the above-identified patent application.

7. The above-identified application is a US national-phase filing based on corresponding Patent Cooperation Treaty (PCT) patent application PCT/GB00/02011.

8. The European Patent Office (EPO) has conducted a search on PCT application PCT/GB00/02011 and issued a PCT Search Report.

9. An Information Disclosure Statement (IDS) has been submitted to the United States Patent Office (USPTO) on January 25, 2001 to disclose the results of the EPO search as stated in the PCT Search Report. Attached is a copy of the filed IDS.

10. I further declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above referenced application or any patent issuing thereon.

Date October 29, 2001



Frank Nguyen

Registration No. 39,790